

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Gerbrand Deetman	:	Examiner: Ogden, Jr., Necholus
	:	
Serial No.: 09/801,883	:	Group Art Unit: 1751
	:	
Filed: March 8, 2001	:	Attorney Docket No.: 713629.354
	:	
For: STABILIZED PHOSPHATE	:	
ESTER-BASED FUNCTIONAL	:	
FLUID COMPOSITIONS	:	Customer No.: 27128
	:	
	:	Confirmation No.: 7184

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Restriction Requirement, dated November 3, 2006, Applicant hereby provisionally elects for prosecution at this time the species designated by the Examiner as relating to a hindered phenol and identifies claims 107-130 as encompassing such species. However, this election is made with traverse without prejudice to the elected species and without prejudice to the non-elected species. This traverse of the Restriction Requirement is not on grounds of any issue of patentability, but on grounds that the Examiner improperly construed the claims.

Reconsideration and withdrawal of the requirement for restriction is respectfully requested. Applicants contend that the Examiner has not properly considered and misinterpreted the Markush Group in claims 107 (d) and 115 (d), both of which contain a combination of at least one hindered phenol and at least one amine compound. Properly construed, this Markush

Group does not include an amine compound by itself, *i.e.* not in combination with a hindered phenol compound. The amine compound is only claimed in combination with a hindered phenol. There are no pending claims directed to only an amine compound or only a hindered phenol. Independent claims 111 and 115 recites a novel combination of additives comprising both an amine, *i.e.* see 111(e) and 115(e), and a hindered phenol, *i.e.* see 111(f) and 115(f). Thus, properly construed the claims do not recite a species containing only an amine compound. Consequently, it is respectfully submitted that the Restriction Requirement is not proper and should be withdrawn.

The Examiner's position set forth in the Action that, should Applicant's traversal of this requirement for election be on the ground that different embodiments of the same invention are presented, this could be considered an admission in a subsequent prior art rejection on the ground that one species is obvious in view of the other, is believed improper and contrary to the law. It is believed clear that Applicant's teaching of equivalency in Applicant's own specification is not available to the Examiner as an admission in a rejection under 35 U.S.C. 103. The equivalence must be disclosed in the prior art. Any disclosure of equivalence in Applicant's specification cannot be used by the Examiner to support his rejection. See In re Ruff et al., 256 Fed. 2d. 590, 118 USPQ 340. Therefore, this portion of the Action would represent an improper use of Applicant's disclosure and Applicant's traversal of this election requirement cannot be used against Applicant in future prosecution of this application.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested. Because Applicants may wish to pursue claims of the non-elected species at a later

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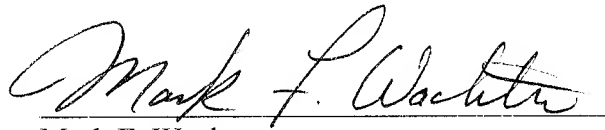
date by Divisional Application, if necessary, it is requested that non-elected claims, pursuant to 37 CFR 1.142, be permitted to remain in the application, but withdrawn from examination.

This response does not present any new matter. Accordingly, as all requirements of the Action have been complied with, an action on the merits and a Notice of Allowance are hereby respectfully requested.

If any issue regarding this election or the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present election, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date: November 28, 2006

A handwritten signature in cursive script, reading "Mark F. Wachter", written over a horizontal line.

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